Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TETSURO MOTOYAMA

Appeal No. 1999-2767
Application No. 08/738,461

Before BARRETT, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant has filed a Request for Rehearing under 37 CFR § 1.197(b) (Paper No. 52), requesting rehearing of our decision entered September 5, 2002, wherein we sustained the final rejection of claims 88-139 under 35 U.S.C. § 103.

In our decision we determined that the metes and bounds of the claim recitation "electronic mail message" was a material inquiry in proper interpretation of the representative claims. Appellant submitted that the term was well known in the art, and that formal definition could be found in technical dictionaries.

After consulting technical dictionaries for the relevant terms, we concluded that the broadest reasonable interpretation of "electronic mail message" did not preclude files transferred by electronic communication over the local area network (LAN) disclosed by one of the two references which the examiner submitted as evidence of obviousness for the claimed subject matter. As a result, we found that the subject matter of the representative claims was anticipated by the reference describing the electronic communication over the LAN. We sustained the examiner's rejection of the claims under 35 U.S.C. § 103 because anticipation has been held to be the "epitome" of obviousness.

Appellant submits that we erred in failing to denominate the affirmance as a new ground of rejection, as provided for by 37 CFR § 1.196(b), and request that we do so. Appellant cites In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976), for the proposition that a rejection must be considered "new" if the appellant has not had a fair opportunity to react to the thrust of the rejection.

Because our interpretation of "electronic mail message" as used in the instant claims was apparently different (i.e., broader) than the examiner's interpretation of the term, we grant the relief requested by appellant. We characterize our affirmance of the rejection as a new ground of rejection under 37 CFR § 1.196(b).

Appellant points to nothing in our opinion that we consider as corresponding to any allegation of error with respect to the merits of the decision. To the extent appellant's request may be construed in any fashion as challenging the merits of the

decision, we stress that we decline to disturb our original opinion other than our grant of the requested relief with respect to the procedural matter, by agreeing that our affirmance is to be considered a new ground of rejection under 37 CFR § 1.196(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

GRANTED-IN-PART

LEE E. BARRETT Administrative Patent Judge	)))))) BOARD OF PATENT
STUART S. LEVY Administrative Patent Judge	) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	))))

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